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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,887	11/26/2003	Thomas M. Laney	87430CPK	1673

7590

09/22/2005

Paul A. Leipold
Eastman Kodak Company
Patent Legal Staff
343 State Street
Rochester, NY 14650-2201

EXAMINER

BUTLER, PATRICK

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/722,887	Applicant(s) LANEY ET AL.	
	Examiner Patrick Butler	Art Unit 1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-18, 27 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-26, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20050502&20031126</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

Applicant's election of Group II, Claims 19-30 in the reply filed on 20 June 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 1-18 are considered withdrawn.

Further restriction to one of the following inventions is required under 35 U.S.C. 121:

This application contains claims directed to the following patentably distinct species of the claimed invention: Claim 20 claims a method drawn to making a monolayer film, and Claims 27 and 28 claim a method drawn to making a multi-layer film.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 19 is generic with respect to the quantity layers.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Chris Konkol on 06 September 2005 an oral election to the above species restriction was made with traverse to prosecute the invention of the species indicated in Claim 20 of monolayer. Affirmation of this election must be made by applicant in replying to this Office action. Claims 27 and 28 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

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The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-26, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al. (US Patent No. 5,443,780) in view of Laney et al. (US Patent No. 6,379,780).

With respect to Claim 19, Matsumoto teaches extruding a film from polyester, specifically extruded polylactic acid, and with biaxial stretching (forming a sheet comprising a layer of polylactic-acid-based material, and stretching the sheet biaxially) (see col. 1, lines 7-9 and col. 4, lines 17-29).

Matsumoto does not teach blending inorganic particles into a melt comprising a polylactic-acid-based material or forming interconnected microvoids.

Laney teaches making a layer of polyester film using a mixture of microbeads made of inorganic material and performing biaxial stretching (blending inorganic particles into a melt; forming a sheet comprising a layer of material containing inorganic particles by extrusion; stretching the sheet biaxially to form interconnected microvoids around the inorganic particles) (see col. 2, lines 35-61; col. 4, lines 22-26; col. 11, lines 31-43, and col. 12, lines 23-27).

It would have been obvious to use Laney's teaching for using microbeads in the polyester material taught by Matsumoto because of the absorbency properties which efficiently absorb printed inks without the need of multiple processing steps or multiple coated layers (see Laney col. 2, line 62 through col. 3, line 1).

With respect to Claim 20, Matsumoto's film does not disclose additional layers and is necessarily monolayer as claimed (see col. 1, lines 36-51; col. 3, lines 17-57; and col. 4, lines 17-29).

With respect to Claim 21, Matsumoto's film is stretched from 55-80 degrees C, which overlaps the claimed range of under 75 degrees C (see col. 2, lines 49-54).

With respect to Claim 22 and 23, Laney's inorganic microbeads are sized within the range of 0.01-10 μ (0.01-10 micrometer), which includes the claimed diameter range of 0.1-1 micrometer and 0.1 – 0.6 micrometer (see col. 4, lines 23-31).

With respect to Claim 24, Matsumoto teaches an example of a film made to a thickness of 100-200 μ m, which reads on the claim of 25-400 μ m (see col. 3, lines 17-21).

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With respect to Claim 25, Laney teaches at least two ranges of the proportion of inorganic particles to use. Example 4 teaches calcium carbonate used as the inorganic particle at 45% by weight content, which reads on the claim in indicates that organic and inorganic particles are interchangeable to perform the invention, which reads on the claimed range of about 45% content by weight (see col. 14, lines 40-45 and col. 13, lines 52-60). Laney teaches using microbeads (inorganic particles) to an extent greater than 30% by volume, which would necessarily include the upper range of the claimed 45-75% by weight (see col. 15, lines 30-32).

With respect to Claim 26, Laney specifically teaches using barium sulfate, calcium carbonate, silica, and alumina, which read on the claim (col. 4, lines 27-31).

With respect to Claim 29 and 30, Matsumoto teaches simultaneous biaxial stretching (stretched in both directions simultaneously) and successive biaxial stretching (sequentially stretched in a machine direction first followed by a transverse direction).

It would have been obvious to one of ordinary skill at the time of the invention to pick of the directions to perform stretching in the machine direction first (machine) before the second direction (transverse).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Butler whose telephone number is 571-272-8517. The examiner can normally be reached on Monday through Friday 7:30 AM - 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571-272-1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick Butler
Examiner
Art Unit 1732



MICHAEL P. COLAIANNI
SUPERVISORY PATENT EXAMINER